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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Jacques Moret, Inc.

v.

Wilson Bright

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Opposition No. 91154648
to application Serial No. 76404402
filed on April 30, 2002

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Alan H. Levine and Howard F. Mandelbaum of Levine & Mandelbaum for Jacques Moret, Inc.

Wilson Bright, *pro se.*

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Before Seeherman, Quinn and Walters, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Jacques Moret, Inc. has opposed the application of Wilson Bright, an individual, to register DRY-X for "waterproof fabric for the further manufacture of clothing."[1] As grounds for the opposition, opposer has

[1] Application Ser. No. 76404402, filed April 30, 2002, based on an asserted intention to use the mark in commerce under Section 1(b) of the Trademark Act.

alleged that it has used the mark DRY F-X for apparel, and the fabric incorporated therein, since 1999; that it owns a registration for DRY F-X for "wearing apparel, namely, leggings and tops"; and that applicant's goods are so closely related to opposer's wearing apparel, and the fabric of which the apparel is made, that applicant's use of his mark is likely to cause confusion or mistake or to deceive.

Applicant has admitted that it seeks registration of DRY-X for "waterproof fabric for the further manufacture of clothing," but otherwise has denied the salient allegations of the notice of opposition.[2]

The record includes the pleadings; the testimony deposition, with exhibits, of opposer's witness Lisa Konorty, vice president of sales support for Jacques Moret, Inc.; and applicant's responses to interrogatory numbers 1 and 15 in opposer's first set of interrogatories, submitted by opposer under notice of reliance. Applicant filed no evidence and took no testimony.

The parties have fully briefed this proceeding. The parties did not request an oral hearing.

[2] Applicant also asserted that opposer failed to state a claim upon which relief can be granted, but did not pursue this defense during the course of the proceeding.

Facts

The evidence shows that since 1999 opposer has used the DRY F-X trademark to identify the source of various types of workout apparel, including leggings, sports bras, exercise tops, and shorts (Konorty deposition, pp. 6, 11-12). The evidence also shows that the mark is used on hang tags for the apparel to identify the fabric that opposer uses to make this finished apparel,[3] which is designed to draw sweat away from the skin of the wearer to the outside of the fabric (Konorty deposition, pp. 6, 11). However, there is no evidence in the record concerning the precise date opposer's mark was first used to identify the fabric in its apparel. Before opposer ships its DRY F-X brand apparel to its only client, the mass marketer Target, opposer attaches an adhesive backed label bearing the DRY F-X mark to the apparel (Konorty deposition, pp. 7-9, 13). Opposer also attaches a folded hang tag to the apparel before shipment: the inside of the hang tag includes the DRY F-X mark with a design and wording indicating that the fabric transports moisture away from the wearer's body (Konorty deposition, pp. 9-11).

[3] There is no evidence that opposer sells this fabric to third parties.

As to channels of trade, as stated above, the evidence shows that opposer's only client for its DRY F-X apparel is Target. All of Target's retail stores sell DRY F-X apparel, and Target has stores in most states of the United States (Konorty deposition, pp. 7, 13-14). Sales of DRY F-X apparel from 2002 to 2004 totaled approximately $30 million wholesale, or approximately $60 million retail (Konorty deposition, pp. 12-13).

Turning to applicant's use of the DRY-X mark, the information we have is rather limited, since the evidence has all been submitted by opposer. The evidence shows that applicant uses the DRY-X mark to identify the source of its woven fabric which has a waterproof coating. Applicant sells the fabric to apparel manufacturers and fabric stores in the United States and abroad (applicant's response to opposer's interrogatory number 1). The apparel manufacturers usually attach to apparel made from applicant's fabric hang tags with the DRY-X mark on them to "promote the quality" of the fabric from which the garments are made, and the hang tags remain on the garments at the point of sale (applicant's response to opposer's interrogatory number 15).

Standing

We find that opposer has, as a seller of apparel under the mark DRY-F-X, established its standing.

Priority

Although opposer alleged ownership of a registration for DRY F-X for "apparel, namely, leggings and tops" in its notice of opposition, it did not attach a status and title copy of the registration thereto as would have been required to make it of record, *see* Trademark Rule 2.122(d)(1), nor did opposer file a notice of reliance with a status and title copy of the pleaded registration, *see* Trademark Rule 2.122(d)(2). Ms. Konorty in her testimony deposition identified a "soft copy" of Reg. No. 2422256 (Exhibit B) and testified as to opposer's ownership of the registration (Konorty deposition pp. 5-6) but not as to the registration's status. Nor did opposer make the registration of record in any other acceptable manner, *see* TMBP §704.03(b)(1) (2d ed. rev. 2004). Accordingly, opposer failed to make the pleaded registration of record.

In view of the above, opposer must rely on its common law rights in the DRY F-X mark as a basis for its claim of priority. Ms. Konorty's testimony establishes that opposer has used DRY F-X continuously on workout apparel since 1999 (Konorty deposition, pp. 6, 11-12). There is no evidence in the record concerning the precise date opposer's mark

was first used to identify the fabric in its apparel, but the record is clear that opposer has used and continues to use the mark in this manner.

Because the application at issue is based on an intent to use the mark in commerce, and there is no evidence regarding when applicant began using the mark DRY-X, the earliest date on which applicant can rely is his April 30, 2002 filing date. *Zirco Corp. v. American Telephone and Telegraph Co.,* 21 USPQ2d 1542, 1544 (TTAB 1991). Thus, in spite of opposer's failure to make its registration for DRY F-X of record, opposer has demonstrated that it has priority based on its common law rights in the mark.

Likelihood of Confusion

This brings us to a consideration of the issue of likelihood of confusion. Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. Du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also*, *In re Majestic Distilling Company, Inc.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). While we have concentrated our discussion on the factors brought up by the parties, we have considered all the factors on which there is evidence.

Turning first to the goods, we must consider the similarity or dissimilarity of opposer's workout apparel and applicant's "waterproof fabric for use in the further manufacture of clothing." The Board has often found clothing and fabric to be related goods. *In re Crompton Co., Inc.,* 221 USPQ 471 (TTAB 1983) (confusion found likely in the contemporaneous use of "REGENCY" for textile fabrics and "REGENCY" for women's sportswear; confusion also found likely in the contemporaneous use of "SPORTEEN" for textile fabrics and "SPORTEENS" for various items of clothing); *Warnaco Inc. v. Adventure Knits, Inc.,* 210 USPQ 307 (TTAB 1981) (confusion found likely in the contemporaneous use of "LUV TOUCH" for fabric and "LOVE TOUCH" for brassieres).

The relatedness of clothing and fabric is demonstrated by the facts in this case. Opposer uses its fabric to manufacture finished apparel. At the point of sale, labels and hang tags bearing opposer's DRY F-X mark identify both the source of opposer's fabric and its finished apparel. Further, applicant's fabric is sold to third parties who use it to manufacture finished apparel. Hang tags on that apparel bear the trademark for applicant's fabric which has been incorporated into the apparel. There is also clearly a relatedness between the fabric that is used in opposer's workout apparel and applicant's waterproof fabric, in that

both have moisture resistant qualities. Moreover, applicant's fabric could be used to manufacture workout apparel such as running jackets. In view of the foregoing, we find that opposer's workout apparel and applicant's fabric are related goods, and that this factor favors a finding of likelihood of confusion.

We turn now to the Du Pont factor of the similarity or dissimilarity of established, likely-to-continue channels of trade. The record shows that opposer's DRY F-X workout apparel is sold in Target stores throughout the United States to the public at large. The record also shows that applicant sells its DRY-X fabric to apparel manufacturers and fabric stores.[4] Thus, apparel made from applicant's fabric (and which bears labeling identifying the trademark for the fabric) could be sold in stores such as Target, and could be sold to the general public. As a result, finished apparel bearing applicant's DRY-X fabric mark could be sold in the same channels of trade as opposer's DRY F-X exercise garments, and the same classes of consumers could encounter apparel bearing opposer's mark, and apparel bearing applicant's fabric mark, when they are sold in these

[4] Although applicant has claimed an intent-to-use filing basis, his responses to interrogatories 1 and 15 concerning his use of DRY-X indicate that the mark is already in use on textiles, i.e., "…Wilson Bright sells textiles to Manufactures [sic] and fabric stores…"

channels of trade. Thus, opposer's and applicant's trade channels must be considered to overlap. *In re Melville Corp.,* 18 USPQ2d 1386, 1388 (TTAB 1991). In view of the foregoing, we find that both parties' goods could be sold in the same channels of trade, and that this factor also favors a finding of likelihood of confusion.

We turn next to the conditions under which and the buyers to whom sales are made, i.e., the level of care exercised by purchasers of opposer's workout apparel, and by the purchasers of the apparel into which applicant's fabric is incorporated. Workout apparel such as leggings, sports bras, exercise tops, and shorts, by its very nature, is not likely to be purchased with a great deal of care. Further, opposer's goods are marketed through Target stores, a mass merchandiser that caters to the general public, and the goods are therefore sold to the public at large, rather than to consumers with a particular expertise or sophistication. Applicant's fabric, too, can be used to manufacture a wide variety of clothing items, including relatively inexpensive goods whose purchase would not be subject to a great deal of care. The buyers of this apparel, like opposer's, would include the general public, rather than sophisticated purchasers. This factor thus favors a finding of likelihood of confusion.

We now turn to the similarity or dissimilarity of applicant's DRY F-X mark as compared with opposer's DRY-X mark. The marks are similar in appearance and sound: both begin with DRY and end in –X. The fact that opposer's mark has the additional letter "F" is a minor difference that does not obviate the marks' similarity in appearance or sound.

Furthermore, we find that the connotations and general commercial impressions of the marks are similar. Both suggest that the wearer of opposer's apparel, or of garments made from applicant's fabric, will remain dry when wearing the clothing.

In reaching our conclusion that the marks are similar, we have considered applicant's argument that the element "–X" will bring to mind "Generation X" and thus distinguish applicant's mark from opposer's in terms of connotation. We are not persuaded by this argument. We see no basis for applicant's claim that this is the connotation that its mark will have because of this element. Rather, we consider it much more likely that consumers will look to the initial element, DRY, which is the same in both marks, as the connotation of marks which are used for waterproof fabric or apparel made from fabric that draws moisture away from the skin. Accordingly, we find that the marks are

similar in appearance, sound, connotation and commercial impression, particularly since, when evaluating the similarity or dissimilarity of marks, the question is not whether they can be distinguished when subjected to a side-by-side comparison. Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller DerbySkate* Corporation, 206 USPQ 255, 259 (TTAB 1980); Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). Therefore, this factor favors a finding of likelihood of confusion.

With respect to the two du Pont factors regarding actual confusion, the record does not contain any evidence of actual confusion. However, there is likewise no evidence about the extent of applicant's use of his mark, and therefore we cannot assume that there has been an opportunity for confusion to occur, or conclude from the lack of evidence of actual confusion that confusion is not likely to occur. We find this du Pont factor to be neutral.

Turning to the factor of fame, opposer has not actually asserted that its mark is famous. In its brief, opposer summarized the sales figures for its DRY F-X

apparel, and asserted that these figures and the length of use of the mark have resulted in "significant penetration" of the mark in the market place. While the record shows that opposer's retail sales of its DRY F-X workout apparel totaled approximately $60 million over the period 2002-2004, opposer has provided no context for these figures. For example, there is no evidence about the total U.S. general or workout apparel market which might allow us to evaluate opposer's market share, or whether this amount of sales is significant. Furthermore, opposer has presented no evidence regarding advertising expenditures in support of its DRY F-X workout apparel. Thus, on the record we cannot find that opposer's mark is famous, and we find this du Pont factor to be neutral.

Turning to the issue of the number and nature of similar marks in use on similar goods, we agree with opposer that there is no evidence in the record on this issue. Therefore, we find this du Pont factor to be neutral, or to slightly favor opposer in terms of indicating the strength of its mark.

Having considered all of the relevant evidence as it pertains to the du Pont factors, we find that applicant's use of DRY-X for "waterproof fabric for the further

manufacture of clothing” is likely to cause confusion as to source with opposer’s mark DRY F-X for workout apparel.

Decision: The opposition is sustained.